

REMARKS

This Application has been carefully reviewed in light of the Official Action mailed January 26, 2005. In order to advance prosecution of the present Application, Claims 1 and 13 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

Claims 1-5 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sheikh, et al. in view of Garcen, et al. and further in view of Davis, et al. Independent Claims 1 and 13 recite in general a peer transaction path being separate from a host transaction path, both connecting a set of network module interfaces, to allow communications between network modules without interfering with host processor communications. By contrast, the Sheikh, et al. patent requires that all communications with peer devices be through a fabric controller for both data and control traffic on the same bus for host and peer devices. Thus, the Sheikh, et al. patent does not provide communications between modules on a separate peer transaction path to avoid interfering with host processor communications as provided in the claimed invention. The Garcen, et al. patent merely provides a host, a switching module, and a plurality of I/O modules. The Davis, et al. patent provides for a host subnetwork with a host bus that connects a host processor to a host-to-PCI bridge and a separate PCI subnetwork with a PCI bus that connects the host-to-PCI bridge to one or more PCI devices. However, the host bus and the PCI bus of the Davis, et al. patent are not both connected to a set of network module interfaces as required in the claimed invention. The combination that would result from placing the switching module of the Garcen, et al. patent into the computer system architecture of the Sheikh, et al. patent with the host bus subnetwork and the PCI bus subnetwork of the

Davis, et al. patent would still lack a plurality of network module interfaces being coupled to a peer transaction bus and a separate host transaction bus that allows network modules to communicate without interfering with host processor communications as provided by the claimed invention. Support for the above recitation can be found at page 7, lines 6-19, of Applicant's specification. Therefore, Applicant respectfully submits that Claims 1-5 and 13-20 are patentably distinct from the proposed Sheikh, et al. - Garcen, et al. - Davis, et al. combination.

Claims 6 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sheikh, et al. in view of Garcen, et al. and Davis, et al. and further in view of Wooten, et al. Independent Claim 1, from which Claims 6 and 10 depend, has been shown above to be patentably distinct from the proposed Sheikh, et al. - Garcen, et al. - Davis, et al. combination. Moreover, the Wooten, et al. patent does not include any additional disclosure combinable with either the Sheikh, et al., Garcen, et al., and Davis, et al. patents that would be material to patentability of these claims. Therefore, Applicant respectfully submits that Claims 6 and 10 are patentably distinct from the proposed Sheikh, et al. - Garcen, et al. - Davis, et al. - Wooten, et al. combination.

Applicant notes with appreciation the allowance of Claims 7-9, 11, and 12.

Applicant respectfully requests withdrawal of the finality of the present Office Action. "Before final rejection is in order a clear issue should be developed between the examiner and applicant." M.P.E.P. §706.07. A clear issue has not been developed between the Examiner and Applicant with respect to the Davis, et al. patent as the Examiner has only now used the Davis, et al. patent to support a rejection of these claims. According to M.P.E.P. §706.07,

hasty and ill-considered final rejections are not sanctioned. "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." M.P.E.P. §706.07. "To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection." M.P.E.P. §706.07.

Applicant responded to the first Office Action of June 16, 2004 and overcame the proposed Sheikh, et al. and Garcen, et al. combination used by the Examiner to reject these claims. Now the Examiner comes back with the Davis, et al. patent in combination with the Sheikh, et al. and Garcen, et al. patents which was available to the Examiner for consideration in the previous Office Action but which the Examiner did not use as a basis for any rejection of these claims in the previous Office Action. The Examiner now uses the Davis, et al. patent in the same manner as the Sheikh, et al. and Garcen, et al. patents were used in the previous Office Action. Thus, the Examiner has not followed the M.P.E.P. where it states that "[s]witching from . . . one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance or a final rejection." Amendments to the claims in response to the previous Office Action did

not substantially change the subject matter of the claims to force the Examiner to now use the Davis, et al. patent where it could not have been used in the previous Office Action.

As a result, Applicant has not been given the cooperation of the Examiner as required and has been denied an opportunity to fully address the Davis, et al. patent and associated new grounds of rejection that could have been cited in the previous Office Action. By not providing Applicant the capability to fully respond to the Davis, et al. patent without the assurance that the response would be considered and entered, the Examiner has prematurely cut off prosecution of the present Application. Applicant has not been given a full and fair hearing to which it is entitled and a clear issue has not been developed as required. Therefore, Applicant respectfully submits that the final rejection is premature and that the finality of the present Office Action be withdrawn.

This Response to Examiner's Action is necessary to address the new grounds of rejection and newly cited art recently presented by the Examiner. This Response to Examiner's Final Action could not have been presented earlier as the Examiner has only now raised a new grounds of rejection and newly cited art in support thereof.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicants

A handwritten signature in dark ink, appearing to read 'Charles S. Fish', with a stylized flourish at the end.

Charles S. Fish

Reg. No. 35,870

March 28, 2005

CORRESPONDENCE ADDRESS:

2001 Ross Avenue, Suite 600

Dallas, TX 75201-2980

(214) 953-6507

Customer Number: 05073